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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/736,872	12/16/2003	Michael Clark Campbell	2002-0643.01	4772

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LEXMARK INTERNATIONAL, INC.  
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LEXINGTON, KY 40550-0999

EXAMINER
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KIM, CHONG R

ART UNIT	PAPER NUMBER
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2624

MAIL DATE	DELIVERY MODE
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11/04/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/736,872	<b>Applicant(s)</b> CAMPBELL, MICHAEL CLARK	
	<b>Examiner</b> CHARLES KIM	<b>Art Unit</b> 2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 July 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2-7 is/are allowed.
- 6) ☒ Claim(s) 1,8-10,15 and 16 is/are rejected.
- 7) ☒ Claim(s) 11-14 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Amendment and Arguments***

1. Applicant's amendment filed on July 17, 2008 has been entered and made of record.
2. Applicant's arguments with respect to the rejected claims have been considered but are moot in view of the new ground(s) of rejection, the details of which are provided below.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 15 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Referring to claim 15, the phrases "said second designation mark" and "said second action" lack antecedent basis. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claims 1, 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Lumley, U.S. Patent Application Publication No. 2001/0052993 (hereinafter Lumley), Nakanishi, U.S. Patent No. 7,031,005 (hereinafter Nakanishi), and Takaragi, U.S. Patent No. 7,058,196 (hereinafter Takaragi).

Referring to claim 1, Lumley discloses a method for selecting images from a plurality of images obtained from a digital device for printing with an imaging apparatus, said imaging apparatus having a scanner and accessing a memory storing said plurality of images, said method comprising the steps of:

printing a thumbnail printout [step 2, fig. 3], the thumbnail printout including a plurality of thumbnails corresponding to the plurality of images [fig. 2];

generating a selection sheet from the thumbnail printout by placing a first designation mark on the thumbnail printout for each thumbnail of the plurality of thumbnails corresponding to each image of the plurality of images on which a first action is to be taken [step 3, fig. 3 and fig. 2];

detecting the first designation mark by scanning the selection sheet with the scanner [step 4, fig. 3];

performing the first action (printing) based on the detecting the first designation mark [step 8, fig. 3].

Lumley does not explicitly disclose the steps of printing a confirmation for confirming to a user that each image on which the first action to be taken is designated and following printing the confirmation, performing the first action based on the detecting the first designation mark. However, these features would have been obvious in view of Nakanishi and Takaragi. For

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example, Nakanishi provides a confirmation for confirming to a user that each image on which a first action (printing) to be taken is designated and following the confirmation, performing the first action (printing) based on the selected images [col. 3, l. 60-col. 4, l. 8]. Nakanishi does not disclose that the confirmation is printed, but rather displayed to the user [col. 3, l. 60-col. 4, l. 8]. Takaragi explains that the steps of displaying and printing are interchangeable [col. 8, ll. 40-41]. Accordingly, the combination of Nakanishi and Takaragi would have suggested to one of ordinary skill to print a confirmation for confirming to a user that each image on which the first action to be taken is designated. Such a combination would have been obvious because the substitution of one known step (displaying the confirmation) for another (printing the confirmation) would have yielded the predictable result of a printed confirmation<sup>1</sup>. Moreover, combining Nakanishi and Takaragi with Lumley would have similarly yielded the predictable result of providing to the user a confirmation of the selected images before printing the selected images. Therefore, Lumley modified in view of Nakanishi and Takaragi would have rendered obvious the steps of printing a confirmation for confirming to a user that each image on which the first action to be taken is designated and following printing the confirmation, performing the first action based on the detecting the first designation mark, as recited in claim 1.

Referring to claim 8, Lumley further discloses that the first action includes printing [step 8, fig. 3].

Referring to claim 9, Lumley further discloses that the first action includes inhibiting printing [fig. 1. Note that the selected image may be inhibited from printing by deleting the images.].

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<sup>1</sup> See *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1395.

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Referring to claim 10, Lumley further discloses that the first action includes deleting from the memory [fig. 1. Note that the selected image may be deleted.].

5. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lumley, Nakanishi, Takaragi, further in view of Miyake, U.S. Patent No. 4,905,090 (hereinafter Miyake).

Referring to claim 16, Lumley, Nakanishi, and Takaragi do not explicitly disclose an alignment sensor used for aligning a print head of the imaging apparatus.

Miyake discloses a scanning sensor (5) that is aligned to print head (6) [col. 3, ll. 3-33 and fig. 2].

Lumley, Nakanishi, Takaragi and Miyake are combinable because they are all concerned with printing systems. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify Lumley, Nakanishi, and Takaragi to include the alignment sensor of Miyake. The reason for doing so would have been to enhance the accuracy of the printing process by ensuring that the print head is properly aligned. Therefore, it would have been obvious to combine Lumley, Nakanishi, and Takaragi with Miyake to obtain the invention as specified in claim 16.

***Allowable Subject Matter***

6. Claims 2-7 are allowed.

7. Claims 11-14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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***Citation of Relevant Prior Art***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Nakano et al., U.S. Patent No. 7,315,391 discloses all the features recited in claim 1 except the step for printing a confirmation.

***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Kim whose telephone number is 571-272-7421. The examiner can normally be reached on Mon thru Thurs 8:30am to 6pm and alternating Fri 9:30am to 6pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bhavesh Mehta can be reached on 571-272-7453. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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October 30, 2008